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GRAY, EXAMINER

ART UNIT

PAPER NUMBER

06/05/98

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09158308

Applicant(s)

Weirather et al.

Examiner

Gray, Linda L.

Group Art Unit

1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9-22-98, 3-22-00, 12-7-98, 12-9-98, 6-25-99, 12-21-99, 2-2-00
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 73-141 is/are pending in the application.
- Of the above claim(s) 105-19 & 108-140 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 73-8790-91, 93-104, 120-127, 141 is/are rejected.
- ☒ Claim(s) 88-89 & 92 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☒ The specification is objected to by the Examiner. (Abstract)
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6 & 8
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Election/Restriction

1. Claims 105-119 and 128-140 are withdrawn from further consideration by the Examiner, 37 CFR 1.142(b), as being drawn to a non-elected group. Election was made without traverse in paper 11.

Specification

2. Applicants are reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because it is more than 250 words, MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 123 is are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard.**

Claim 123 is indefinite because it is unclear how facestock can be removed, step e, before it is cut, step b.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 120-121 and 126 are rejected under 35 U.S.C. 102(b) as being anticipated by Fagnant et al. (US 5,976,294).**

Claim 120, Fagnant et al. teach providing sheet construction 36 including liner sheet 12 and facestock sheet 18, cutting sheet 18 without cutting sheet 12 to form printable media 44, cutting sheet 12 without cutting sheet 18 to form a plurality of spaced liner strips on sheet 18 and webs of interconnected liner waste strips between adjacent strips 58, and removing each web as a single unit itself from sheet 18 (c 2, L 14, to c 3, L 46).

Claim 121, removing also includes a step of removing waste sheet 18 (end strip). The limitation that the exposed strip defines a printer infeed end is an intended use limitation of the product made by the claimed method which does not provide a patentable distinction between the pending claims and the applied prior art. **Claim 126**, cutting of sheet 12 is after cutting of sheet 18.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 73-87, 90-91, 93-104, 122-125, 127, and 141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fagnant et al. (US 5,976,294).**

Claims 73 and 141, Fagnant et al. teach providing laminate sheet construction 36 including liner sheet 12 and facestock sheet 18 adhered with an adhesive layer to sheet 12, cutting through sheet 18 to sheet 12 to form facestock cut lines defining at least in part perimeters of printable media 44, and cutting through an outer face of sheet 12 to form liner-sheet cut lines defining a plurality of longitudinal liner sheet strips 58 on a backside of facestock 18.

Claims 73 and 141, Fagnant et al. do not specifically teach the construction of sheet 12 to the point that this release liner includes a film to be between sheets 12 and 18.

It is conventional that release liners include a base layer with a release layer thereon.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. a release film on sheet 12 to be between sheets 12 and 18 because it is obvious to replace one liner form (that of Fagnant et al. where the specifics are not disclosed) with another art recognized alternative liner form (layer with release film thereon) used for the same purpose.

Claim 74, Fagnant et al. teach removing waste sheet 18 ("end strip) which exposes a top surface of sheet 12 ("end one of strips 58"). The limitation that the exposed strip defines a printer infeed end of construction 36 is an intended use limitation of the product made by the claimed method which does not provide a patentable distinction between the pending claims and the applied prior art. The same applies to the limitation of **claim 75**.

Claims 76-77, 80, and 103, Fagnant et al. does not teach printing after cutting but prints before cutting.

However, MPEP § 2144.04 ("Changes in Sequence of Adding Ingredients") indicates that the particular order (i.e., "ingredient" = when to print) is prima facie obvious in the absence of new or unexpected results.

With respect to vertical and horizontal ink jet printers (claims 76 and 77), such printers are conventional alternatives to roll printers.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. vertical or horizontal ink jet printers instead of roll printers because such are conventional alternatives to roll printers and it is obvious to replace one printer (roll printer) with another art recognized printer (vertical or horizontal ink jet printer).

Claim 81, the removing step includes peeling. **Claim 82**, strips 58 cover the cut lines of media 44. **Claim 83**, alternate strips 58 are removed. **Claim 78**, removal of waste sheet 18 occurs before sheet 12 is cut.

Claims 79 and 122-123, Fagnant et al. do not teach removing waste sheet 18 after sheet 12 is cut.

However, MPEP § 2144.04 ("Changes in Sequence of Adding Ingredients") indicates that the particular order (i.e., "ingredient" = when to remove waste sheet 18) is prima facie obvious in the absence of new or unexpected results. The same applies to **claim 123**.

Claim 84, Fagnant et al. teach feeding sheet 18 through printer E for a printing operation on sheet 18 to print on media 44 formed thereby. **Claim 85**, media 44 are separated from strips 58 during use which is after cutting. **Claim 86**, a user peels media 44 from strips 58. **Claim 87**, the limitation of using media 44 of Fagnant et al. as a business card is an intended use limitation of the product made by the claimed method. **Claim 91**, cutting of sheet 12 is after cutting of sheet 18. **Claim 90**, the cut lines for strips 58 are wavy curved shaped. **Claim 93**, the cut lines of sheet 18 define entire perimeters of media 44. **Claim 94**, sheets 12 and 18 are die cut using rollers.

Claims 95 and 104, Fagnant et al. do not teach laser cutting instead of roll cutting.

Laser cutting is a conventional alternative to roll cutting and such provides for a very clean cut.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. laser cutting instead of roll cutting because laser cutting is a conventional alternative to roll cutting, where, such provides for a very clean cut, and it is obvious to replace one kind of cut (roll cutting) with another art recognized kind of cut (laser cutting).

Claim 96, Fagnant et al. do not teach sheet 12 to be densified bleach kraft paper with low density polyethylene thereon.

However, such a combination is a conventional type of liner sheet used to support media such as media 44 because the liner sheet is very durable.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. teach sheet 12 to be densified bleach kraft paper with low density polyethylene thereon because such a combination is a conventional type of liner sheet used to support media such as media 44 because the liner sheet is very durable and it is obvious to replace on type of liner sheet (Fagnant et al.) with another art recognized type of liner sheet.

Claim 97, the adhesive is pressure sensitive and contacts the film layer of Fagnant et al.

Claim 97, Fagnant et al. do not teach the adhesive to be hot melt.

It is conventional to use hot melt adhesive because such adhesive is easily applied when hot.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. that the adhesive is hot melt adhesive because is easily applied

when hot.

Claim 98, construction 36 with sheets 12 and 18 in the position shown in Figures 1, and sheet 12 is up depending upon one's point of reference.

Claims 98-99 and 125, *Fagnant et al. do not teach storing construction 36 in roll form before cutting.*

It is conventional to store web material in roll form between operations as a means of having an efficient back log of material to work from.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. storing construction 36 in roll form before cutting because is conventional to store web material in roll form between operations as a means of having an efficient back log of material to work from.

Claims 100-102, 124, and 127, *Fagnant et al. do not teach calendering construction 36 before cutting.*

It is conventional to calender an endless web to keep tension within the web for cutting.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Fagnant et al. calendering of construction 36 because it is conventional to calender an endless web to keep tension within the web for cutting.

Allowable Subject Matter

11. Claims 88-89 and 92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: while the prior art of record teaches the limitations of claim 73, the prior art of record does not teach the following:

claim 88, feeding sheet 18 by automatically feeding such in a stack of same from an automatic feed tray of the printer and into the printer; **claim 89**, diagonally extended strips 58; and **claim 92**, performing the operation on a sheet cut from construction 36 instead of a continuous web of construction 36.

13. Since allowable subject matter has been indicated, Applicants are encouraged to submit formal drawings in response to this Office action. The early submission of formal drawings will permit the Office

to review the drawings for acceptability and to resolve any informalities remaining therein before the application is passed to issue. This will avoid possible delays in the issue process.

14. As allowable subject matter has been indicated, Applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with, 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

15. Any inquiry concerning this communication or earlier communications should be directed to Examiner Linda L. Gray at (703)308-1093, Monday-Friday from 8:00 am to 4:30 pm. The necessary fax numbers are (703)305-7718 (official), (703)305-7115 (unofficial), and (703)305-3599 (after final).

llg
June 2, 2000

Linda L. Gray
Linda L. Gray
Patent Examiner